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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,147	02/16/2001	Kevin H. Gillespie	06129-158001	4293

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EXAMINER

PATTERSON, MARIE D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

NR

<b>Office Action Summary</b>	Application No. 09/788,147	Applicant(s) GILLESPIE, KEVIN H.	
	Examiner Marie Patterson	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17-23 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-23 and 26-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 112***

1. Claims 1-15, 17-23, and 26-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 22, and 26 the phrase "the recessed region serving to position said lower cushion surface....force of heel strike" is vague and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. There is no guidance in the specification as to what structure is intended to provide such. Such a limitations appears to be dependent on the weight of the wearer, height of jump/step, etc..

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8, 11, 13-15, 17, 22, 23, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Schenkel (Brazil publication PI 9800597-9).

Schenkel shows a shoe comprising an outsole (formed by C, T, S, and R) with apertures (VT and VD), and cushions (E) which are located, flow and bulge through the apertures (as shown in figures 5, 6, and 8-10) but do not contact the ground surface as claimed.

3. Claims 1, 4, 5, 6, 11, 12, 15, 17, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Fuerst (4897936).

Fuerst shows a shoe with an outsole with apertures (28 and 30) and inserts (50 and 52) therein which bulge and protrude through the apertures as claimed. In reference to the functional recitation of "the lower surface.....spaced above the floor....under the wearer's weight and force of heel strike" (the heel strike during walking is discussed in column 1 line 65-column 2 line 2).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 11, 15, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preston (5287638) in view of Fuerst.

Preston shows a shoe with an aperture (21) and cushion (24) in the heel of an outsole and a recess in the lower surface of the outsole (figure 3) substantially as claimed except for the exact depth of the recess in the lower surface of the outsole. Fuerst teaches providing a recess in the lower surface of an outsole with a "sufficient depth" so that the insert (52) does not engage the walking surface during heel strike and weight, which is considered to at least cover "walking" as claimed (see column 1 line 65 – column 2 line 2). It would have been obvious to make the recess of a sufficient depth

as taught by Fuerst in the shoe of Preston to prevent excessive wear on the insert and thereby extend the useful life of the shoe.

In reference to claims 2 and 3, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use rubber and thermoplastic resins, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

6. Claims 1 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duclos (4724624) in view of Fuerst.

Duclos shows a shoe comprising an outsole with a grid pattern and loop (figure 2) substantially as claimed except for an aperture in the heel with a cushion. Fuerst teaches providing an insert (52) in an aperture in the heel of an outsole and a recess in a lower surface of the outsole (figure 3). It would have been obvious to provide an aperture, recess, and cushion as taught by Fuerst in the shoe of Duclos to increase cushioning and shock absorption.

7. Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parisotto (5768806) in view of Fuerst.

Parisotto shows a shoe comprising an outsole with a grid pattern on the top surface of the outsole (figure 1) substantially as claimed except for an aperture in the heel with a cushion. Fuerst teaches providing an insert (52) in an aperture in the heel of an outsole and a recess in a lower surface of the outsole (figure 3). It would have been obvious to

provide an aperture, recess, and cushion as taught by Fuerst in the shoe of Parisotto to increase cushioning and shock absorption.

8. Claims 1, 5, 6, 11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dyer (5325611) in view of Fuerst.

Dyer shows a shoe substantially as claimed except for a recess in the lower surface of the outsole. Fuerst teaches providing a recess in the lower surface of an outsole with a "sufficient depth" so that the insert (52) does not engage the walking surface during weight bearing and heel strike force, which is considered to at least cover "walking" as claimed (see column 1 line 65 – column 2 line 2). It would have been obvious to make the recess of a sufficient depth as taught by Fuerst in the shoe of Dyer to increase cushioning and to prevent excessive wear on the insert and thereby extend the useful life of the shoe.

9. Claims 1, 3, 4, 12, 15, 17-23, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavone (6009637) in view of Fuerst.

Pavone shows a shoe substantially as claimed except for a recess in the lower surface of the outsole. Fuerst teaches providing a recess in the lower surface of an outsole with a "sufficient depth" so that the insert (52) does not engage the walking surface during normal play, which is considered to at least cover weight and heel strike while walking inasmuch as claimed (see column 1 line 65 – column 2 line 2). It would have been obvious to make the recess of a sufficient depth as taught by Fuerst in the shoe of Pavone to prevent excessive wear on the insert and thereby extend the useful life of the shoe.


***Response to Arguments***

10. Applicant's arguments filed 1/9/03 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards Fuerst, Fuerst clearly states "said central portion is not ground engaging in normal play but engages the ground under appropriate player weight distribution conditions" (column 1 line 67- column 2 line 2). Normal play includes heel strike forces include heel strike during walking and normal play heel strike forces and therefore meets the claim language.

In response to applicants' arguments directed towards Pavone, the silicone bladder structure of Pavone would inherently flow/bulge through the openings/apertures to some degree. It is not an invention to perceive that the product which others had discovered had qualities they failed to detect. (National Distillers and Chemical Corporation v. Brenner, 156 USPQ 163, 854 OG 844).

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 Customer Service Center number is (703) 306-5648. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner cannot confirm receipt of faxes) Please identify Examiner \_\_\_\_ of Art Unit \_\_\_\_ at the top of your cover sheet of any correspondence submitted. Inquiries only concerning the merits of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069. If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337. Check out our web-site at "www.uspto.gov" for fees and other useful information.

  
Marie Patterson  
Primary Examiner  
Art Unit 3728